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10/580,289

05/24/2006

Doron Tam

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EXAMINER

RANDALL, JR., KELVIN L

ART UNIT

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3651

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DELIVERY MODE

12/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,289	Applicant(s) TAM ET AL.	
	Examiner Kelvin L. Randall, JR.	Art Unit 3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 2-8 and 12-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,9-11 and 19-25 is/are rejected.
- 7) ☒ Claim(s) 26-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/24/2006 and 10/20/2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 08/05/2009 have been fully considered but they are not persuasive.

Applicant's Arguments Re Claims 1 and 19:

The Examiner contends that with Mossler's newspaper vending apparatus, "once a consumer retrieves a newspaper from the dispenser in a forward direction the nearest newspaper becomes dispensed to an opposite planar surface of the plate." Office Action at 4. Applicant respectfully disagrees. The Examiner does not contend that Mossman expressly describes this feature, but instead apparently contends that it is inherent in the operation of the apparatus.

However, in Mossler's apparatus, the newspaper is pulled down and away from the lower most surface of the structure identified as the plate by the Examiner (AS). A user could readily pull the newspaper out of the apparatus and away from plate A5 without ever pulling it to the opposite planar surface of A5. Thus, at best, the rejection is predicated on one possible mode of operation of Mossier.

Applicant's Arguments Re Claim 20:

Mossler's device dispenses the newspaper. However, it is clear that upon rotating Mossler's rotatable shaft B, the newspaper is merely dispensed downward and away from plate AS, not to the opposite planar surface of the plate. Thus, Mossier and Schlumpf fail to disclose or suggest the "dispensing"

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limitation of claim 20. Moreover, claim 20 recites "automatically stopping rotation of said shaft after dispensing said *nearest* one bag." In Brenner's device, rotation is stopped after dispensing the bag that is *furthest* from the bag-supporting surface. For this reason as well, claim 20 is distinguishable over the references of record. Schlumpf does not compensate for Mossler's deficiencies. Thus, claim 20 is allowable over the cited references. Reconsideration and withdrawal of the rejection are respectfully requested.

Examiner's Response Re Claims 1, 19, and 20:

Examiner notes that inherency is not being used in this situation. Examiner notes that there is no structural language within the claim that would support the Applicant's assumption that the bag will dispense to the other side of the plate other than its intended use. Examiner notes that a recitation with respect to the manner in which an apparatus is intended to be employed does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); In re Yanush, 477 F.2d 958, 177 USPQ 705 (CCPA 1973); In re Finsterwalder, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971); In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963); Ex parte Masham, 2 USPQ2d 1647 (BdPatApp & Inter 1987). Examiner further notes that the explanation given was merely to provide reason for a bag to dispense to the opposite side of the plate where the structure given in the claim has already been anticipated.

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Examiner notes that Mossler's device is capable of dispensing to the other side of the plate as broadly claimed within claim 1, simply, by presenting a bag outside of the container on the opposite side since there is no structure which limits the meaning of dispensing or distinguishes how the bag reaches the other side. For the reasons stated above, the claims as previously presented stand rejected.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "first and second end" as recited in claims 26, 27, and 28 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must

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be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 26, 27, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner notes that the claims mention first and second ends which have not been described in the specification and it is unclear as to which end is being referred too.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the

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remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mossler in view of Schlumpf, Stanley Brenner (3,503,481 – hereinafter Brenner), and Churchman.

Re Claims 1 and 19:

Mossler teaches a device for dispensing a newspaper from a stack of newspapers, the device comprising: a plate (A5) mounted on a frame (page 1

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lines (63-82), said plate (A5) defining a planar newspaper-supporting surface and an opposite planar surface (see Fig. 2- opposite planar surface being the opposite side of plate A5); a rotatable shaft (B) coupled/mounted to said frame (page 2 lines 18-50); at least one roller (B') non-rotatably affixed to said shaft (B) and arranged to engage a newspaper of the stack of newspapers nearest said planar newspaper-supporting surface (A5) (see Fig. 1); means (c3) for rotating said shaft whereby said nearest newspaper is shifted over said at least one roller (B') (page 2 lines 88-95 and see Fig. 2- Examiner associates means for language to correspond to means as described in Applicant's Detailed Description page 6 lines 25-27); wherein the stack of newspapers is held against said planar newspaper-supporting surface (A5), and when said rotatable shaft rotates, said nearest newspaper is thereby dispensed to said opposite planar surface side of said plate (A5) (Examiner notes that once a consumer retrieves a newspaper from the dispenser in a forward direction the nearest newspaper becomes dispensed to an opposite planar surface side of the plate), said plate (A5) being disposed between said dispensed nearest newspaper and the stack of newspapers (see Examiner's previous comment) (see Figs. 1-5), but fails to specifically teach bags (Examiner notes that the claim does not specifically set forth that bags are a requirement), a bag detector coupled to the means for rotating said shaft, such that when the bag detector detects the presence of a bag, the rotatable shaft stops rotating, and the device further comprises a bag retaining element coupled to said plate for pressing the stack of bags against said at least one roller.

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Schlumpf teaches bags (col. 1 lines 20-25). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler with the bags of Schlumpf because they are within the same art and are commonly recognized by one of ordinary skill in the art to be interchangeable and commonly used one in place of the other.

Brenner teaches a bag detector (42) coupled to a means for rotating a shaft, such that when the bag detector detects the presence of a bag, the rotatable shaft stops rotating (Examiner notes the shaft as engaging wheel (34) through rotatably journaled bearing (33)) after a single bag has been dispensed (see col. 4 lines 15-31 and col. 5 lines 40- 52). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler and Schlumpf with the bag detector of Brenner, because they are in the same art and one of ordinary skill in the art in looking for a transition from a coin operated manual dispenser to a coin operate automatic dispenser would have seen the combination of the two and the use of a sensor as a means as obvious within the dispensing art. However, both Mossler and Brenner fail to teach the device further comprises a bag retaining element coupled to said plate for pressing the stack of bags against said at least one roller.

Churchman teaches the device further comprises a newspaper retaining element (23) coupled to a plate (21) for pressing the stack of newspapers against at least one roller (see Fig. 3 and page 1 lines 44-57). Re Claim 19: Churchman teaches an elongate guide mounted adjacent rollers to guide dispensed newspapers away from the rollers (see Fig.3 guide below roller). Re claim 26: Churchman teaches Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler, Schlumpf, and Brenner with the retaining element and guide as suggested in the Churchman disclosure because they are all within the same art and one of ordinary skill in the dispensing art would have seen Churchman's retaining element as an obvious alternative to Mossler's retaining element (A7).

5. Claims 9 -11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mossler in view of Schlumpf, Brenner, and Churchman, and further in view of Eugene Coleman (US 2001/0032859 – hereinafter Coleman).

Re Claims 9 and 10:

Mossler in view of Schlumpf, Brenner, and Churchman teach the device of claim 1, but fail to teach a second rotatable shaft mounted parallel to said rotatable shaft on an extension of said frame; at least one roller non-rotatably affixed to said second shaft; wherein each roller on said rotatable shaft is coupled to a

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roller on said second shaft, whereby rotation of said rotatable shaft causes concomitant rotation of said second shaft and a bag retaining bar.

Coleman further in view teaches a second rotatable shaft (75) mounted parallel to a rotatable shaft (73) on an extension of a frame (see Fig. 7); at least one roller (75) non-rotatably affixed to said second shaft (75); wherein each roller on said rotatable shaft (73) is coupled to a roller on said second shaft (75) (see 82 of Fig. 7), whereby rotation of said rotatable shaft (73) (by 86) causes concomitant rotation of said second shaft (75) (see Fig. 7 and paragraphs [0055 and 0056]) and said rotatable shaft (73) is disposed between said second rotatable shaft (75) and a bag retaining element (at 84) Re Claim 10: Coleman teaches wherein a bag retaining element (84) includes a bag-retaining bar (top of 84) for engaging and retaining a stack of sheets against said at least one roller (70) before and during dispensing (see Fig. 7 and paragraph [0057]). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler in view of Schlumpf, Brenner, and Churchman with Coleman's disclosure because they are within the same art one of ordinary skill ion the art looking for a commercial or public use dispenser would see the combination as a way to increase the efficiency of the dispenser. (Examiner notes that there is no claim language present in claim 9 which requires "an extension" to be anything other than a piece of housing).

Re Claims 11:

Mossler in view of Schlumpf, Brenner, and Churchman, teach the device of claim 1 and an arm pivotally coupled to said plate (see Mossler Fig. 2), but fail to teach including a bag retaining bar and a bag retaining arm, but fail to teach wherein an arm is pivotally coupled to said plate.

Coleman teaches including a bag retaining bar (top of 84) and a bag retaining arm (84) (see Coleman Fig. 7). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler in view of Schlumpf, Brenner, and Churchman with Coleman's disclosure because they are within the same art one of ordinary skill in the art looking for a commercial or public use dispenser would see the combination as a way to increase the efficiency of the dispenser.

1. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mossler in view of Schlumpf.

Re Claim 20:

Mossler teaches a method for dispensing a newspaper from a stack of newspapers, the method comprising: holding a stack of newspapers against at

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least one roller (B') non-rotatably affixed to a rotatable shaft (B) coupled to a plate (A5) mounted on a frame (page 2 lines 18-50- Examiner notes coupled through frame) and defining a planar newspaper supporting surface and an opposite planar surface (see Fig. 2); dispensing one newspaper from said stack of newspapers nearest said planar newspaper supporting surface to said opposite planar surface of said plate (A5) (Examiner notes that once newspapers is dispensed it is capable of being held/dispensed to an opposite planar surface of said plate) by rotating said rotatable shaft (see page 6 lines 25-27, and Figs. 1-5); and automatically stopping rotation of said shaft after dispensing said nearest one bag (Examiner notes that only one newspaper is dispensed at a time thus automatically stopping after 1st newspaper is dispensed), but fails to teach of bags.

Schlumpf teaches bags (col. 1 lines 20-25). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler with the bags of Schlumpf because they are within the same art and are commonly recognized by one of ordinary skill in the art to be interchangeable and commonly used one in place of the other.

2. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mossler in view of Schlumpf and further in view of Brenner.

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Re Claims 21-23:

Mossler in view of Schlumpf teaches the device of claim 20 and dispensing of a nearest newspaper, but fail to teach wherein said step of automatically stopping includes detecting presence of a dispensed bag adjacent a dispensed bag detector; and stopping rotation of said shaft in response thereto.

Brenner teaches wherein said step of automatically stopping includes detecting presence of a dispensed bag adjacent a dispensed bag detector (42) ; and stopping rotation of said shaft in response thereto (col. 5 lines 47-53). Re Claim 22: Brenner teaches drivingly coupling a motor (34) to said rotatable shaft (100), such that actuation of said motor cause said rotatable shaft to rotate; and causing said at least one roller (32) to engage one bag in said stack of bags, such that rotation of said rotatable shaft causes said at least one roller to remove said bag from said stack of bags (col. 4 lines 15-53). Re Claim 23: Brenner teaches wherein said step of automatically stopping includes automatically stopping said motor in response to dispensing a single bag from the stack (col. 5 lines 47-53). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler and Schlumpf with the means for automatically stopping rotation as noted in the Brenner disclosure, because they are in the same art and one of ordinary skill in the art in looking for a transition from a coin operated manual dispenser to a coin operate automatic dispenser would have seen the

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combination of the two and the use of a sensor as a means as obvious within the dispensing art.

3. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mossler in view of Schlumpf and further in view of Coleman.

Re Claims 24 and 25:

Mossler in view of Schlumpf teaches the device of claim 20 and dispensing of a nearmost newspaper, but fail to teach wherein at least one roller is non-rotatably affixed to a second rotatable shaft, said second shaft is mounted parallel to said rotatable shaft, said rotatable shaft is disposed between said second rotatable shaft and said one bag from said stack of bags, and said at least one roller on said rotatable shaft is coupled to said at least one roller on said second shaft, whereby rotation of said rotatable shaft causes concomitant rotation of said second shaft.

Coleman further in view teaches a second rotatable shaft (75) mounted parallel to a rotatable shaft (73), said rotatable shaft (73) is disposed between said second rotatable shaft (75) and said one bag from said stack of bags (see Fig. 7); at least one roller (74) non-rotatably affixed to said second shaft (75); wherein each roller on said rotatable shaft (73) is coupled to a roller on said second shaft (75) (see 82 of Fig. 7), whereby rotation of said rotatable shaft causes concomitant rotation of said second shaft (see Fig. 7 and paragraphs [0055 and

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0056])). Re Claim 25: Coleman teaches drivingly coupling a manual (86) rotation means to said rotatable shaft, such that actuation of said manual rotation means rotates said shaft (see Fig. 7). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler in view of Schlumpf with Coleman's disclosure because they are within the same art one of ordinary skill in the art looking for a commercial or public use dispenser would see the combination as a way to increase the efficiency of the dispenser.

Allowable Subject Matter

4. Claims 26-28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory

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action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin L. Randall, JR. whose telephone number is (571)270-5373. The examiner can normally be reached on Monday-Friday 8:30 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571)272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gene Crawford/
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